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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,691	07/16/2004	Ryuichi Oda	TOYA115.013APC	7122
20995 7590 05/01/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER CROW, ROBERT THOMAS	
			ART UNIT 1634	PAPER NUMBER
			NOTIFICATION DATE 05/01/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/501,691

Applicant(s)

ODA ET AL.

Examiner

Robert T. Crow

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 1 and 3-7.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 3/04, 9/04, 9/05
13. ☐ Other: _____.

Continuation of 5. Applicant's reply has overcome the following rejection(s): the rejection of claims 1 and 4-6 under 35 USC 102(b) as anticipated by Zimlich et al. Zimlich et al do not explicitly teach carriers made of the instantly claimed thermoplastic resins.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues on page 5 of the Remarks filed 23 April 2007 that the recitation "spotting a solution consisting essentially of the biomolecule" is not open-ended and thus does not encompass the alleged additional components of Jacobsen et al.

However, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355 ("PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). See also AK Steel Corp. v. Sollac, 344 F.3d 1234, 1239-1240, 68 USPQ2d 1280, 1283-84 (Fed. Cir. 2003); In re Janakirama-Rao, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). A cursory review of the specification yields no limiting definition of "consisting essentially of." Thus, "consisting essentially of" is construed as equivalent to "comprising" and the scope of the claims are therefore unchanged. See MPEP 2163.

Applicant argues on pages 6-7 of the Remarks that the teachings of Zimlich et al are non-analogous art and that there is no motivation to combine the references.

In response to applicant's argument that Zimlich et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Zimlich et al specifically teach immobilization of polynucleotides to carriers, as acknowledged by Applicant on page 6 of the Remarks. Thus, Applicant has in fact acknowledged that the prior art of Zimlich et al is analogous to the prior art of Jacobsen et al, which also teaches the immobilization of polynucleotides to carriers.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Zimlich et al specifically teach that the irradiation dose produces good results even with variations in the substrate (column 6, lines 42-45). In addition, Zimlich et al also teach hybridization has the added advantage of allowing DNA sequencing to be performed (column 1, lines 5-20).

Thus, as outlined in the previous Office Action, it would have been obvious to a person of ordinary skill in the art at the time the claimed invention was made to have modified the method of Jacobsen et al with the teachings of Zimlich et al with a reasonable expectation of success. The ordinary artisan would have been motivated to make such modifications because said modifications would have resulted in the added benefits as described above and in the previous Office Action.

Applicant further argues on pages 5-6 of the Remarks that Jacobsen et al do not teach a solution consisting essentially of the biomolecule, and that the teachings of Jacobsen et al do not remedy this alleged deficiency.

However, these arguments refer to the amended claims and rely solely on the amendments. Applicant has provided no further arguments not already considered. Since the amendments were not entered, the arguments are moot. Therefore, these arguments drawn to the after final amendments have not been considered.

The newly initialed Information Disclosure sheets have been provided as per Applicant's request on page 5 of the Remarks. However, the previously initialed references are already on the record, and have been lined through to avoid duplication.



**BJ FORMAN, PH.D.
PRIMARY EXAMINER**